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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,192	12/01/2003	Jeffrey A. McFadden	10005.001810	9840
31894 7590 06/19/2007 OKAMOTO & BENEDICTO, LLP P.O. BOX 641330 SAN JOSE, CA 95164			EXAMINER BOVEJA, NAMRATA	
			ART UNIT 3622	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/725,192	Applicant(s) MCFADDEN, JEFFREY A.	
	Examiner Namrata Boveja	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/13/06 and 12/26/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 12/01/2003.
2. Claims 1-21 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4, 9, and 12 are rejected under 102(b) as being anticipated by Sawyer Patent Number 6,084,628 (hereinafter Sawyer).

In reference to claim 1, Sawyer teaches a method of delivering advertising to a telephone user, the method comprising: detecting an interest by a user in a destination telephone number (i.e. user makes a call) (col. 4 lines 6-22); determining a category of the destination telephone number (i.e. a call to the user's wife, brother, or some other recipient) (col. 4 lines 6-22); and providing the user an advertisement based on the category of the destination telephone number (abstract, col. 2 lines 4-11, 31-35, 50-52, and 58-62, col. 3 lines 5-12, 28-33, and 55-67, col. 4 lines 6-22, and Figure 2).

4. In reference to claim 2, Sawyer teaches the method wherein the user manifests the interest in the destination number by calling the destination telephone number (col. 4 lines 15-22).

5. In reference to claim 4, Sawyer teaches the method wherein the

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advertisement is shown on a display of a telephone employed by the user (i.e. via a videoconference device) (col. 2 lines 43-61 and Figures 2-4).

6. In reference to claim 9, Sawyer teaches the method wherein the advertisement includes a hyperlink to data relating to the advertisement (col. 2 lines 4-11 and col. 3 lines 28-51).

7. In reference to claim 12, Sawyer teaches the method wherein the advertisement is selected according to behavioral information compiled on the user (col. 3 lines 5-33, col. 3 lines 55 to col. 4 lines 22).

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13, 14, and 18-20 are rejected under 102(e) as being anticipated by Bookstaff Patent Number 7,227,936 (hereinafter Bookstaff).

In reference to claim 13, Bookstaff teaches a method of providing advertisements to telephone users, the method comprising: grouping a plurality of telephone numbers into a plurality of categories (i.e. pizza parlors) (col. 6 lines 45-66), each of the categories having a plurality of corresponding advertisements (col. 7 lines 4-10), each of the plurality of advertisements being ranked based on an amount paid by an associated advertiser (col. 15 lines 17-24); detecting an

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interest by a user in a telephone number in a category in the plurality of categories (col. 15 lines 25-38); and providing the user a highest ranked advertisement corresponding to the category (col. 13 lines 52-58 and col. 15 lines 17-24 and 32-49).

9. In reference to claim 14, Bookstaff teaches the method wherein advertisers bid to obtain a ranking in the category (col. 15 lines 17-24).

10. In reference to claim 18, Bookstaff teaches a method of receiving advertisements in a telephone, the method comprising: making a telephone call to a telephone number (col. 6 lines 48-54 and col. 15 lines 25-38); and receiving an advertisement based on the telephone number (col. 6 lines 48 to col. 7 lines 16 and col. 15 lines 32-62).

11. In reference to claim 19, Bookstaff teaches the method wherein the telephone number and the advertisement belong to different businesses providing similar products (i.e. different beauty parlors or pizza parlors) (col. 6 lines 48 to col. 7 lines 16 and col. 15 lines 17-62).

12. In reference to claim 20, Bookstaff teaches the method of claim 18 wherein the advertisement is received before the call to the telephone number is completed (abstract, col. 6 lines 66 to col. 7 lines 4, col. 14 lines 60-66, col. 15 lines 39-51, col. 17 lines 25-38 and 58-60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 3 is rejected under U.S.C. 103(a) as being unpatentable over Sawyer in view of Endo Publication Number US 2003/019509 (hereinafter Endo).

In reference to claim 3, Sawyer does not teach the method wherein the advertisement is delivered to a mobile phone employed by the user. Endo teaches the method wherein the advertisement is delivered to a mobile phone employed by the user (abstract, page 4 paragraph 54, and Figure 1). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Sawyer to include the delivery of advertisements to mobile phones, since users would no longer need to be bound to a landline to receive advertisements and could receive advertisements that are more targeted to the user based on where the user is at the time the user received the phone call.

14. Claim 5 is rejected under U.S.C. 103(a) as being unpatentable over Sawyer in view of Official Notice.

In reference to claim 5, Sawyer teaches showing advertisements on a display of a telephone employed by the user (i.e. via a videoconference device) (col. 2 lines 43-61 and Figures 2-4). Sawyer does not teach showing the advertisement as a pop-up window. Official Notice is taken that it is old and well known to show advertisements in a pop-up window as done frequently by Internet websites to attract the user's attention. It would have been obvious to a

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person of ordinary skill in the art at the time of the applicant's invention to show advertisements in Sawyer's invention in a pop-up window to focus the user's attention to the advertisement by having the user either click on the advertisement, move the advertisement, or close the advertisement and hence require some kind of user interaction with the advertisement rather than enabling the user to simply ignore the advertisement.

15. Claims 6-8 are rejected under U.S.C. 103(a) as being unpatentable over Sawyer in view Bookstaff Patent Number 7,227,936 (hereinafter Bookstaff).

In reference to claim 6, Sawyer does not teach the method wherein the advertisement and the destination telephone number belong to different business establishments providing similar or related products. Bookstaff teaches the method wherein the advertisement and the destination telephone number belong to different business establishments providing similar or related products (i.e. different pizza parlors or hair salons) (col. 6 lines 48 to col. 7 lines 16 and col. 15 lines 17-62). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Sawyer to include providing the advertisement and the destination telephone number belonging to different business establishments providing similar or related products to give the user an opportunity to select among the advertisers for a desired product or service.

16. In reference to claim 7, Sawyer does not teach the method wherein the advertisement is from an advertiser who pays the most among advertisers in the category. Bookstaff teaches the method wherein the advertisement is from an advertiser who pays the most among advertisers in the category (col. 13 lines 52-

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58 and col. 15 lines 17-24). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Sawyer to include providing the advertisement from an advertiser who pays the most among advertisers in the category to maximize the advertising revenues obtained from presenting the advertisement to the user.

17. In reference to claim 8, Sawyer does not teach the method further comprising: providing the user a speed dial to a destination telephone number for the advertiser paying for the advertisement. Bookstaff teaches the method further comprising: providing the user a speed dial to a destination telephone number for the advertiser paying for the advertisement (i.e. user's call can be forwarded) (col. 3 lines 58-67, col. 6 lines 10-14, 35-37, and 55-62). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Sawyer to include providing the user a speed dial to a destination telephone number for the advertiser paying for the advertisement to encourage the user to contact the advertiser right away without requiring the user to hang up and call the advertiser at a later time.

18. Claims 10 and 11 are rejected under U.S.C. 103(a) as being unpatentable over Sawyer in view Yasuhiko Publication Number JP111260621A (hereinafter Yasuhiko, see attached translation).

In reference to claims 10 and 11, Sawyer does not teach the method wherein the data comprises a map and a coupon. Yasuhiko teaches the method wherein the data comprises a map and a coupon (page 10 lines 1-21 and Figure 8). It would have been obvious to a person of ordinary skill in the art at the time

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of the applicant's invention to modify Sawyer to include providing the user a map and a coupon to assist the user in locating the advertiser and to motivate the user to make a purchase from the advertiser.

19. Claim 15 is rejected under U.S.C. 103(a) as being unpatentable over Bookstaff in view of Endo Publication Number US 2003/019509 (hereinafter Endo). In reference to claim 15, Bookstaff does not teach the method wherein the advertisement is delivered to a mobile phone employed by the user. Endo teaches the method wherein the advertisement is delivered to a mobile phone employed by the user (abstract, page 4 paragraph 54, and Figure 1). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Bookstaff to include the delivery of advertisements to mobile phones, since users would no longer need to be bound to a landline to receive advertisements and could receive advertisements that are more targeted to the user based on where the user is at the time the user received the phone call.

20. Claims 16 and 21 are rejected under U.S.C. 103(a) as being unpatentable over Bookstaff in view of Sawyer.

In reference to claim 16, Bookstaff does not teach the method wherein the advertisement includes a hyperlink to data relating to the advertisement. Sawyer teaches the method wherein the advertisement includes a hyperlink to data relating to the advertisement (col. 2 lines 4-11 and col. 3 lines 28-51). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Bookstaff to include providing the user a hyperlink

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to data relating to the advertisement to enable the user to receive more information than just the phone number of the advertiser.

21. In reference to claim 21, Bookstaff does not teach the method wherein the advertisement is displayed on a display of a telephone employed by a user to make the call. Sawyer teaches the method wherein the advertisement is displayed on a display of a telephone employed by a user to make the call (i.e. via a videoconference device) (col. 2 lines 43-61 and Figures 2-4). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Bookstaff to include providing the user an advertisement that is displayed on a display of a telephone employed by a user to make the call to enable the user to receive more information than just the phone number of the advertiser visually.

22. Claim 17 is rejected under U.S.C. 103(a) as being unpatentable over Bookstaff in view Yasuhiko Publication Number JP111260621A (hereinafter Yasuhiko, see attached translation).

In reference to claim 17, Bookstaff does not teach the method wherein the data comprises a map and a coupon. Yasuhiko teaches the method wherein the data comprises a map and a coupon (page 10 lines 1-21 and Figure 8). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Bookstaff to include providing the user a map and a coupon to assist the user in locating the advertiser and to motivate the user to make a purchase from the advertiser.

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **FAX number** for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).


NB

June 6th, 2007


RETTA YEHDEGA
PRIMARY EXAMINER